

REMARKS

The Office Action mailed on December 01, 2004, has been reviewed and the comments of the Patent and Trademark Office have been considered. Prior to this paper, claims 20-39 were pending. By this paper, Applicants cancel claim 25 without prejudice or disclaimer, place claims 21, 27 and 33 into independent form, and do not add any claims. Therefore, claims 20-24 and 26-39 are now pending in the present application.

Applicants respectfully submit that the present application is in condition for allowance for the reasons that follow.

Indication of Allowable Subject Matter

Applicants thank Examiner Gray for indicating that claims 21, 24, 33, 35, 36 and 37-38 would be allowable if placed into independent form. In response, Applicants have placed claim 21 and 33 into independent form, with minor amendments made to the language incorporated from claim 20 into claim 21.

Claim Objections

Claims 21, 24, 33, 35, 36 and 37-38 are objected to as depending from a rejected base claim. As seen above, claims 21 and 33 no longer depend from a rejected claim, due to the incorporation of the recitations of claims 20 and 32, respectively, therein (with, as noted above, minor amendments being made to the language incorporated from claim 20). Applicants respectfully submit that the objections to claims 21 and 33 should be withdrawn for at least the reason that these claims no longer depend from a rejected claim. Applicants further respectfully submit that the objections to the remaining claims should be withdrawn because they depend from allowable claims.

Claims 27, 28 and 31

In the Office Action, Claims 27, 28 and 31 are not rejected for any identified reason. Since no prior art is identified in the Office Action as rendering these claims unpatentable, Applicants assume that these claims are allowable. Therefore, Applicants have placed claim 27 into independent form, and amended the dependency of claim 31 to depend from claim 27 (claim 28 already depended from claim 27.)

Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 20, 22, 23, 24, 32 and 34 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Applicants have amended claims 20, 22, 23 and 34 as seen above, and respectfully traverse the rejection of claim 32.

The Office Action asserts, with respect to claims 20 and 23,¹ that the phrase “giving a degree of brightness to said intermediate coating” is vague. Specifically, the Office Action asserts that it “is not clear as to how the steel core is given a degree of brightness.” As seen above, step “c” of claim 20 is amended as follows:

~~giving a degree of brightness to said intermediate coating by~~
drawing said coated steel core so that said intermediate coating
obtains a bright looking surface

From this amendment, it is clear that the bright looking surface is obtained by “drawing said coated steel core.”

The Office Action further specifically asserts that it “is not clear as to what constitutes ‘a degree of brightness.’” As seen above, claim 20 now reads that the coating obtains “a bright looking surface.” Thus, any issue as to what is meant by “degree,” is now moot.

¹ And also with respect to claim 32, but the language identified in the Office Action as giving rise to the indefiniteness rejection is not present in claim 32. This is discussed below.

Finally, in regards to claims 20 and 23, the Office Action specifically asserts that step “d” is vague and indefinite. As seen above, Applicants have amended step “d,” to affirmatively recite that the polyester is “obtained.” Reconsideration of claim 20, and claims 23-24, which depend from claim 20, is respectfully requested.

Applicants submit that claim 32 is allowable without amendment. Claim 32 recites that the steel core is drawn “to obtain a bright looking surface.” It does not recite “a *degree* of brightness,” and the meaning of a bright looking surface would be readily ascertained by the skilled artisan. Claim 32 also does not recite “using a transparent thermoplastic polyester.” Reconsideration of the rejection of claim 32 is respectfully requested.

The Office Action asserts that claims 22 and 34 are indefinite “because there are no clear method steps directly defining how the polyester is colored.” In response, Applicants have amended these claims, as seen above, and respectfully request reconsideration. Support for this amendment may be found, among other places, at page 6 of the specification.

* * * * *

Applicants respectfully submit that one of ordinary skill would understand how the steel core obtains its bright looking surface in view of the teachings of the specification. Moreover, Applicants submit that the skilled artisan would also understand what is meant by “a bright looking surface.” At a minimum, a bright looking surface will always be distinguishable from a dull looking surface. Still further, the reference relied on in the Office Action to reject claim 25, Pennis’ article entitled “Hot Dip Galvanizing,” discusses bright galvanized finishes. The article “Hardware,” also used in the Office Action, likewise discusses “bright zinc finishes.” It is respectfully submitted that the skilled artisan would recognize what is meant by a bright looking surface. Applicants remind the PTO that it is the Examiner’s burden to provide evidence showing that language of a claim is indefinite, and that mere conclusory statements of indefiniteness are not sufficient, especially in view of the fact that the present application is directed towards obtaining a wire with a bright looking surface, and contains sufficient teachings to enable one of ordinary skill in the art to obtain such a surface. Indeed, MPEP §2173.05(b), entitled “Relative Terminology,” states that the

“fact that claim language, including terms of degree, **may not be precise, does not automatically** render the claim indefinite . . . Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.” (Emphasis added, citations omitted.) The claims are not indefinite.

Claim Rejections Under 35 U.S.C. §103(a)

In the Office Action, Claims 25-26, 29-30, and 39 are rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of six separate references. In response, in order to advance prosecution, Applicants cancel claim 25, and amend the dependencies of claims 26, 29, 30, 31 and 39 to depend from claim 27, an allowable claim, since claim 27 is not identified as being rejected in view of any prior art. Applicants respectfully submit that the obviousness rejections are now moot in view of the above amendments.

Moreover, two of the references cited are not prior art to the application. The Pennisi reference bears a printing date of November 20, 2004, and a copyright date of 1999 (no month is given). The reference entitled “Hardware (Special Order),” bears a printing date of November 20, 2004. **All of these dates are after the priority date of the present application, which is December 15, 1998**, the date of filing of European Patent Application No. 98204259.0, the application from which the present application properly claims priority. Thus, these references are not prior art.

Conclusion

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a

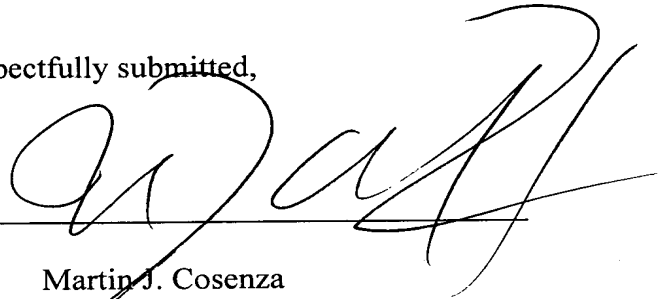
check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Examiner Gray is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date March 6, 2005

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